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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,498	11/19/2003	Eric Donsky	38055.00007.UTL1	8240

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BAKER & MCKENZIE
PATENT DEPARTMENT
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EXAMINER

JACKSON, ANDRE K

ART UNIT PAPER NUMBER

2856

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Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No. 10/718,498	Applicant(s) DONSKY, ERIC	
	Examiner André K. Jackson	Art Unit 2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-101 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-74 and 86-101 is/are allowed.
- 6) ☒ Claim(s) 75-83 is/are rejected.
- 7) ☒ Claim(s) 84 and 85 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a lens placed in the chamber; a set of contact lenses and placing them in the chamber must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are

not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 59 is objected to because of the following informalities:

Claim 59 contains two periods. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 75-77 are rejected under 35 U.S.C. 102(b) as being anticipated by York.

Regarding claim 75, York discloses in the patent entitled "In vivo osmometer" determining a volume of a fluid to be used when testing osmolarity using the osmolarity testing device; measuring electrical properties associated with the determined fluid volume; and establishing a baseline osmolarity value for the osmolarity testing device based on the

measured electrical properties associated with the determined fluid volume (Abstract, Figures 1,5,6; Column 2,3).

Regarding claim 76, York discloses where the volume of fluid is determined based on the dimensions of a measuring chamber that comprises a part of the osmolarity measuring device (Figures 1,5,6).

Regarding claim 77, York discloses where measuring electrical properties associated with the determined fluid volume comprises measuring an electrical conductivity of the volume of fluid (Abstract, Figures 1,5,6; Column 2,3).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 78-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over York in view of Josefsen et al.

Regarding claim 78, York does not disclose where measuring the electrical conductivity comprises providing a plurality of electrodes within

the measuring chamber, and bringing the liquid in contact with the plurality of electrodes. However, Josefsen et al. disclose in the patent entitled "Disposable sample card having a well with electrodes for testing a liquid sample" where measuring the electrical conductivity comprises providing a plurality of electrodes within the measuring chamber, and bringing the liquid in contact with the plurality of electrodes (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify York to include where measuring the electrical conductivity comprises providing a plurality of electrodes within the measuring chamber, and bringing the liquid in contact with the plurality of electrodes. By adding this feature the apparatus would be able to accurately evaluate the liquid sample.

Regarding claim 79, York does not disclose applying a current to the liquid through the plurality of electrodes. However, Josefsen et al. disclose applying a current to the liquid through the plurality of electrodes (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify York to include applying a current to the liquid through the plurality of electrodes. By adding this feature the apparatus would be able to accurately evaluate the liquid sample.

Regarding claim 80, York does not disclose coupling a processing device to the measurement device to measure the electrical properties of the liquid. However, Josefsen et al. disclose applying a current to the liquid through the plurality of electrodes (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify York to include coupling a processing device to the measurement device to measure the electrical properties of the liquid. By adding this feature the apparatus would be able to accurately evaluate the liquid sample.

Regarding claim 81, York discloses displaying the baseline osmolarity value on a visible display (44).

Regarding claim 82, York discloses storing the electrical conductivity value on a memory device (42).

7. Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over York in view of Josefsen et al. and further in view of Ogasawara et al.

Regarding claim 83, York does not explicitly disclose providing a base unit to include the processing device and the memory device. However, Ogasawara et al. disclose in the publication entitled "Electrical conductivity of tear fluid in healthy persons and keratoconjunctivitis sicca patients measured by a flexible conductimetric sensor" where it is known to provide a base unit to include the processing device and the memory

device Figure 2, Page 1, Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify York to include providing a base unit to include the processing device and the memory device. By adding this feature the apparatus would be able to accurately display and measure the fluid within the device.

8. Claims 1-74 and 86-101 are allowed.
9. Claims 84 and 85 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to André K. Jackson whose telephone number is (571) 272-2196. The examiner can normally be reached on Mon.-Thurs. 7AM-4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2856

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.J.

September 27, 2005


HEZRON WILLIAMS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800